

REMARKS/ARGUMENTS

Support for Amendments

The amendments to Claim 1 are supported by Claim 1 as originally filed and by specification page 4, line 12. The amendments to Claims 2-5, 8-10, 13 and 14 are supported by these claims as originally filed. New Claims 15-19 are supported by Claim 1. No new matter has been entered.

Restriction Requirement

Applicants repeat their traversal of the Restriction Requirement. Whether the special technical feature shared by the restricted inventions is initially viewed as patentable by the Examiner has nothing to do with establishing a proper basis for restriction. If such were the case no Restriction Requirement could be successfully traversed. In addition, the special technical feature has been misidentified herein.

Request for Rejoinder

Withdrawn claims 10, 11 and 14 all refer back to, and thus incorporate, the limitations of Claim 1. Should Claim 1 be found allowable, MPEP 821.04(b) directs the rejoinder and allowance of Claims 10, 11 and 14 with Claim 1. Such rejoinder is requested herein.

Specification Objection, 35 U.S.C. 112 rejection

The Specification Objection and 35 U.S.C. 112 rejection have been addressed by the above amendments. The Examiner is thanked for the close review of the application and claims.

Obviousness Rejection

Applicants traverse the obviousness rejection.

Cavallotti is directed to *reducing* water present in imidoalkanepercarboxylic acids.

The present invention, on the other hand, relates to an aqueous dispersion of an imidoalkanepercarboxylic acid with a nonionic surfactant *in water*. Cavallotti admittedly uses no surfactant, and for good reason: a surfactant would make it impossible for Cavallotti to separate his melted imidoalkanepercarboxylic acid phase from his water phase as no separation would occur - the surfactant would keep the melted imidoalkanepercarboxylic acid in solution with the water. See page 2, lines 36-39 of Cavallotti. There is thus no reason one of ordinary skill in the art would modify Cavallotti by adding a nonionic surfactant as doing so would render Cavallotti unsatisfactory for its intended purpose and change the principle of operation of the reference, both of which establish the fact that there is no suggestion or motivation to make the proposed modification. See MPEP 2143.01:

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

"Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function." *In re Dance*, 160

F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a "means for recovering fluid and debris" in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.).

VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Accordingly, Cavallotti is a nonstarter with regard to establishing a *prima facie* case of obviousness against the pending claims.

Barnes, already recognized as being unable, on its own, to establish a *prima facie* case of obviousness is clearly lacking in any suggestion or description of the presently claimed aqueous dispersion. For example, Barnes teaches that the total surfactant amount present in his compositions should be "from 2 to 50% by weight" (page 6, line 5) and in his Examples uses 2.25, 0.9, 1.0 and 1.5% of ethyloxylated alcohol surfactant, all of which are significantly higher than that presently claimed. In addition, Barnes equates, e.g., nonionic surfactants with anionic surfactants which, as shown in Examples 2A and 2D herein (both containing PAP, see specification pages 16 and 18) is not the case: the anionic surfactant-based formulation becomes pasty in a short time (>10,000 mPa.sec), while the invention nonionic surfactant-

based formulation keeps its initial viscosity. This effect is provided by the nonionic surfactant at very low amounts, as claimed. The anionic surfactant does not have this effect.

Accordingly, and as demonstrated above, as Cavallotti is not available in attempting to establish a *prima facie* case of obviousness against the pending claims, and Barnes is insufficient, on its own, to provide such a case, the rejection should be reconsidered and withdrawn.

Double Patenting

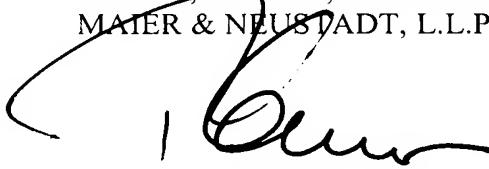
Applicants traverse the double patenting rejections over U.S. 7,468,387 and application Serial No. 12/039,797. Nothing in the claims of U.S. 7,468,387 suggest an aqueous dispersion or a nonionic surfactant, as claimed herein. The fact that the claims of U.S. 7,468,387 and the claims pending herein may have one element in common is insufficient basis for a double patenting rejection. With regard to application Serial No. 12/039,797, this application is clearly later-filed. According to MPEP 804 if a provisional nonstatutory obviousness-type double patenting rejection is the only rejection remaining in the earlier filed of the two pending applications the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Conclusion

For the reasons stated above Applicants respectfully submit that this case is in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

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